AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/699530
Filing Date: October 30, 2000
Title: METHODS AND SYSTEMS FOR RENDERING AN ELECTRONIC PAGE

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REMARKS

This is in response to the Office Action mailed on February 12, 2004, and the references cited therewith.

Claims 1, 9, and 17 are amended; as a result, claims 1-20 are now pending in this application.

§112 Rejection of the Claims

Claims 1-8 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended the preamble of claim 1 to now clearly recite that it is "a method of inserting footnotes implemented in a computer readable medium." There is no longer any ambiguity as to what is intended to be claimed. Accordingly, this rejection is no longer appropriate.

Claims 17-20 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended the preamble of claim 17 to now clearly recite that it is "a method of managing rendered footnote data implemented in a computer readable medium." There is no longer any ambiguity as to what is intended to be claimed. Accordingly, this rejection is no longer appropriate.

§101 Rejection of the Claims

Claims 1-20 were rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. It is a matter of well-settled law that software is patentable subject matter, to this end Applicant has amended the preamble of independent claims 1, 9, and 17 to recite "implemented in a computer readable medium." Accordingly, Applicant believes that this has addressed the Examiner's rejection in the manner that as was requested by the Examiner. Thus, these rejections should be withdrawn.

§*102 Rejection of the Claims*

Claims 1-6 and 9-16 were rejected under 35 USC § 102(b) as being unpatentable by

Chirokas et al. (U.S. Patent No. 5,111,397). It is of course fundamental that in order to sustain

an anticipation rejection that each and every element in the rejected claims must be taught or

disclosed in the cited reference. Here, Chirokas does not insert footnote body data in the

manners positively recited in Applicant's amended independent claims 1 and 9.

More specifically, Chirokas explains an elaborate process for ensuring footnote data is

properly placed on pages. This is explained in detail in FIGS. 6 and 7A. Applicant would like to

direct the Examiner's attention to reference 206 in particular. It is noted that when a footnote is

encountered at 206 information regarding that footnote is placed in a queue and then processed

in manners described in FIG. 7A. This approach is similar to conventional approaches which

require complex calculations and batch processing.

Conversely, as Applicant's original specification explains in detail a more efficient

technique is implemented by the Applicant's invention. This technique is positively recited in

Applicant's amended independent claims 1 and 9, and the technique is entirely different than the

one elaborated on in Chirokas. Specifically, in Applicant's invention, when footnote body data

is inserted, the non footnote body data is dynamically moved to second locations by "inverting"

within the media. This ensures that footnote body data will fit within the media, it does not

require complex calculations or batch processing, and unlike Chirokas it permits (if desired) an

entire contiguous unit of footnote body data to remain on a same unit of the media (*e.g.*, page)

with no carry over when that footnote body data is voluminous. Specifically, see col. 2, lines 43-

54 where Chirokas discusses elaborate requirements for carrying over footnote data which do not

fit on a page.

Chirokas does not teach or suggest any technique that inverts non footnote body data

within a unit of media when footnote body data is being inserted into that same unit of media.

Applicant's amended independent claims 1 and 9 clearly recite this limitation and technique.

Essentially, non footnote body data and footnote body data temporarily switch places within the

unit of media when footnote body data is dynamically encountered. This is now positively

recited in Applicant's amended independent claims 1 and 9. Accordingly, Chirokas fails to teach

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each and every step of Applicant's amended independent claims 1 and 9. Thus, the Applicant respectfully request that the rejections be withdrawn.

Moreover, claims 2-8 are dependent from amended independent claim 1; and claims 10-16 are dependent from amended independent claim 9. Thus, these claims are allowable in view of the amendment and remarks presented above with respect to amended independent claims 1 and 9.

Claims 17-20 were rejected under 35 USC § 102(b) as being unpatentable by Cuan et al. (U.S. Patent No. 4,503,515). Again, it is fundamental that in order to sustain an anticipation rejection that each and every step of the rejected claim must be disclosed or suggested in the cited reference. Cuan does not teach or recite the limitation of "inverting' as is now positively recited in Applicant's amended independent claim 17. Thus, this rejection is no longer appropriate.

Again, Cuan provides yet another complex solution including numerous calculations for processing footnotes. But, Cuan fails to even remotely suggest that that problem can be solved by dynamically inverting data within a unit of media when footnote data is sequentially encountered within that unit of media as it is being processed. This inversion is positively recited as a limitation in Applicant's amended independent claim 17. Accordingly, the rejection with respect to Cuan cannot be sustained because Cuan fails to teach or suggest each and every step of Applicant's amended independent claim 17. Additionally, claims 18-20 are allowable since they depend from independent claim 17 and since Cuan fails to teach or suggest each step of that independent claim 17.

Applicant would like to point out that footnote processing is a difficult problem; this was discussed in Applicant's original specification and elaborated on in both Cuan and Chirokas. Cuan and Chirokas provide very specific techniques for footnote processing, these are associated with batch processing (even Cuan requires a pass on the data after a unit of media is provided thus making it a batch technique) and require calculations. These batch processing techniques and complex calculations are not needed at all in Applicant's invention, because Applicant's independent claims invert the unit of media when footnotes are encountered. Inversion is not assembling as the Examiner suggests, because the assembling is specifically defined in Cuan and

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Chirokas and it is not defined or eluded to as being inversion. Thus, Applicant cannot agree that Cuan or Chirokas teach or even remotely suggest Applicant's independent claim limitations. Accordingly, Applicant respectfully request that these rejections be withdrawn and the claims be allowed.

§*103 Rejection of the Claims*

Claims 7 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Chirokas et al. (U.S. Patent No. 5,111,397) in view of Ferrel et al. (U.S. Patent No. 5,860,073). Claims 7 and 8 are dependent from amended independent claim 1. Therefore, for the amendments and remarks provided herein above with respect to claim 1, claims 7 and 8 should be allowed and the rejections withdrawn.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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